

REPLY UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER 3700

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

JERRY IGGULDEN

Serial No.: **10/500,779**

Filed: **09/21/2004**

For: **METHOD AND APPARATUS FOR
TEMPORARILY MARKING A
POINT OF CONTACT**

Art Unit: **3711**

Examiner: **Wong, Steven B.**

REQUEST FOR RECONSIDERATION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the outstanding Final Office Action mailed January 11, 2007, Applicant requests favorable reconsideration of the pending claims based on the following remarks.

Claims 5-8, the only claims pending in the application, have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Prinz in view of Walker and Adams. Prinz merely discloses the construction of a conventional tennis ball having increased deformation for beginner's play. Walker discloses a process for manufacturing a practice golf ball with a fabric cover able to carry a marking powder for the purpose of leaving a mark at a point of impact. Adams discloses a golf tee marking system in which colored coatings are applied to a golf tee. The colored coatings are preferably a flat enamel-based paint, but may also include a

microencapsulated dye. The Examiner contends that it would have been obvious to one of ordinary skill in the art to provide the outer surface of a tennis ball such as taught by Prinz with a powder thereon, as taught by Walker, in order to mark the points of impact with the ball. The Examiner further contends that it would have been obvious to modify this combination by replacing the marking powder with a microencapsulated marking agent as taught by Adams. Finally, without citation to any authority whatsoever, the Examiner contends that it would have been obvious to use a heat-activated adhesive in order to securely adhere the microcapsules to the felted outer surface of the ball.

Applicant respectfully disagrees with the Examiner's analysis. Adams teaches mixing dye-containing microcapsules with an enamel paint and then applying the paint mixture to a golf tee. Such a method of application is clearly unsuitable for use with a tennis ball since the paint would totally transform the surface characteristics of the ball. At best, the combination of references advanced by the Examiner would yield a tennis ball completely unsuitable for play. There is simply nothing within any of the cited references to suggest coating the microcapsules with an adhesive activated by one of heat or radiation, then applying the microcapsules to a felted outer surface of a tennis ball, and then activating the adhesive to adhere the microcapsules to the ball.

The rejection of claims 5-8 appears to be clearly an instance of hindsight reconstruction, using the claims of the subject application as a road map to combine disparate prior art references. In this case, significant portions of the claimed subject matter cannot even be found in the cited references. As has been well established, a rejection under 35 U.S.C. § 103(a) based on a combination of references is appropriate only if there is some teaching or motivation within the references to combine them in the suggested manner. As explained above, there is no teaching or motivation whatsoever to adhere microcapsules to a

felted outer surface of a tennis ball in the manner recited in the pending claims. Accordingly, the rejection of claim 5-8 under 35 U.S.C. § 103(a) should be withdrawn.

It should be noted that the present Examiner fully considered the Prinz and Walker references in connection with the parent of the subject application, which issued as U.S. patent No. 6,726,584. Although available at the time, the Adams reference was not expressly considered in the parent application. Since the claims of the subject continuation application recite the method for producing the claimed subject matter of the parent patent, Applicant believes that the presently pending claims are also allowable, especially in view of the fact that the particular method of adhering microcapsules to the felted outer surface of a tennis ball is not disclosed in the prior art of record.

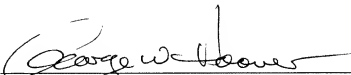
Based on all of the foregoing, Applicant believes that claims 5-8 are in condition for allowance and notice to such effect is respectfully requested at the earliest possible date. In order to preserve Applicant's right of appeal until such time as the Examiner has considered the foregoing arguments, a Notice of Appeal is filed concurrently herewith.

Respectfully submitted,

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Dated: April 10, 2007

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Suzanne Johnston

4/10/07
Date